

09/450,262

MS137797.1

Remarks

Claims 1-4, 6-14, and 16-26 are currently pending in the subject application, and are presently under consideration. Favorable reconsideration of the application is requested in view of the comments herein.

It is respectfully requested that the finality of the Office Action dated November 19, 2002 be removed for at least the following reasons. Each and every claim limitation along with previously submitted arguments were not considered or rebutted by the Examiner. Thus, a *prima facie* basis for rejection under 35 U.S.C. §102(e) and/or or 35 U.S.C. §103(a) has not been established. Moreover, the primary reference (McCollom, *et al.* (US 6,343,274)) has been cited out of context from the actual teachings thereof *vis a vis* the subject claimed invention.

I. Rejection of Claims 1-4, 6-14, and 16-20 Under 35 U.S.C. §102(e)

Claims 1-4, 6-14, and 16-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by McCollom, *et al.* (US 6,343,274). Withdrawal of this rejection is respectfully requested for at least the following reasons. McCollom, *et al.* neither discloses nor suggests each and every element of applicants' invention as recited in the subject claims.

For a prior art reference to anticipate, 35 U.S.C. § 102 requires that "*each and every element as set forth in the claim is found, either expressly or inherently, described, in a single prior art reference.*" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

A. McCollom, et al. fails to disclose or suggest transmitting information to an entity associated with an ad or display message upon detecting activation of the ad or display message

As noted in the previous Reply to Office Action dated June 19, 2002, independent claims 1, 8, 11 and 18, recite in part ... transmitting information to an entity associated with an ad or display message *upon detecting activation of the ad or display message*, the information regarding the current cluster. McCollom, *et al.* does not disclose or suggest transmitting information regarding the current cluster associated with the ad or display message upon detecting activation of the message. A merchant within McCollom, *et al.* manually must request a report and then specify the information wanted within the report (*See* col. 6, lines 52-55, 61-67, col. 7 lines 1-19). In the claimed invention,

09/450,262

MS137797.1

the transmitted information regarding the current cluster associated with the ad or display message is transmitted to the entity *upon selection of the ad* without any intervening actions by the entity - the advertising entity does not request any report. Thus, information is transmitted to advertisers in much more rapid, efficient, and automated manner than disclosed or suggested in McCollom, *et al.* Information transferred in this manner therefore clearly provides more utility to recipients of information since it is timely transmitted upon selection rather than the manual and more laborious efforts required by McCollom, *et al.* Accordingly, since each and every claim element is neither disclosed nor suggested in McCollom, *et al.*, it is respectfully submitted that this rejection be withdrawn.

As noted above, arguments raised in the previous Reply dated June 22, 2002 do not appear to have been considered by the Examiner. The claim limitation of transmitting information to an entity upon ad selection was discussed in the previous arguments and has not been rebutted (not discussed in any of the Examiner's arguments) - let alone disclosed or suggested in McCollom, *et al.* (See col. 6 lines 61-67 and col. 7 lines 1-19 cited by Examiner).

In view of the above, it is readily apparent that McCollom, *et al.* does not anticipate the claimed invention and this rejection should be withdrawn.

B. McCollom, et al. fails to disclose or suggest transmitting information regarding the current cluster

Independent claims 1, 8, 11, and 18 recite in part transmitting information to an entity associated with an ad or display message upon detecting activation of the display message, *the information comprising information regarding the current cluster.*

McCollom, *et al.* neither discloses nor suggests transmitting information regarding the current cluster. The Examiner cites col. 6, lines 61-67 and col. 7 lines 1-19 as disclosing such aspect. Before proceeding, the subject cited sections of McCollom, *et al.* are provided below:

The reports can include but are not limited to the following information: Total number of impressions; Average number of impressions per client; Average time spent viewing an ad (i.e. impression duration); Graph of number of times ad seen vs. time of day; Average percentage of ad seen (e.g. on average, clients saw 92% of the ad); Total number of click-throughs (user clicks on ad URLs); Number of customers where the merchant is a favorite; Share of favorites slot—number of customers listing merchant as a favorite vs. total customers that have favorites (including breaking this down by category as well, e.g. of customers who list shoe stores in their favorites, a specific merchant is listed 71.3% of the time); Ad share—Of all ads a customer has viewed, how many have been from this merchant; Time share—Of all ads, favorites, banners, etc., how much time have customers spent on

09/450,262

MS137797.1

average "viewing" the merchant; What share of ad clicks does the merchant get (number clicks to the merchant vs. clicks to other merchants); Distribution of the host domains used to access the merchant via the consumer registry (e.g. 75% from the .com domain, 10% from the .edu domain, etc.); Average connection speed of consumers connecting to the merchant registry and which visit the merchant; Breakdown of customer's screen resolution & screen depth; Distribution of client default browser settings.

Nowhere in McCollom, *et al.* is it disclosed or suggested to transmit information regarding a *current cluster* of ads. Rather, the information transmitted (*See* the above citation) is related solely to the performance of the ad (e.g., number of clicks) without any consideration given to the *cluster* of ads that may also be displayed therewith. In one example from the above citation, merely providing a number of clicks for the merchant's ad versus other merchants does not define or provide information regarding a current cluster of ads since there is *no defined relationship* (e.g., cluster) between the respective merchant's ads in McCollom, *et al.* Therefore, one merchant's ad getting a certain number of "hits" versus another merchant merely provides an absolute value of the number hits without defining or providing *any context* for the cluster in which the ad was displayed.

In sharp contrast to McCollom, *et al.*, the present invention employs cluster information to determine information such as demographic information, for example, from the context or cluster of ads from which the selected ad was grouped. The information provided at selection time enables advertisers to learn general information while maintaining privacy for users. Such information can include what group of users the users are within as derived from an association with the cluster or subset of ads similarly grouped which is neither disclosed nor suggested in McCollom, *et al.* As such, withdrawal of this rejection is respectfully requested.

C. *McCollom, et al. fails to "inherently" disclose or suggest transmitting information regarding the current cluster or ads having a selection probability*

In the Examiner's response to previous arguments filed August 26, 2002, the Examiner argues that transmitting information regarding the current cluster is inherent to the McCollom system. In addition, an ad having a selection probability was deemed to be inherent in McCollom. These arguments are improper.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of

09/450,262

MS137797.1

circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The McCollom system simply transfers advertising data compiled for individual ads. The mere fact that advertising data is employed by the McCollom system is not sufficient to suggest transferring current cluster data as claimed in the subject invention. There is no mention or suggestion in McCollom, *et al.* of transmitting cluster data from which the ad was displayed. As discussed above, data transmitted regarding the current subset or cluster from which an ad is displayed is employed to derive other useful information (from the subset or cluster) for the advertiser while maintaining privacy for the user in accordance with the claimed invention. Rather, the purported inherency conclusion appears to be based on improper hindsight, in which the subject application provides the missing teaching or suggestion. *See, e.g., Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Thus, it is improper to argue that the McCollom, *et al.* system inherently provides the aforementioned cluster aspects when it is readily apparent this feature can only be derived from the subject invention, and therefore, this rejection should be withdrawn.

Furthermore, independent claims 1 and 11, recite selecting an ad to be displayed on a web page as one of a plurality of ads within a current cluster, each of the plurality of ads having a respective **selection probability** for being displayed ..., whereas independent claims 8 and 18 recite detecting activation of a display message, the display message associated with a current cluster and having a **selection probability** within the current cluster for being displayed.

Contrary to the present claimed invention, McCollom, *et al.* entails an ad-slot purchasing system - merchants have an option of buying slots for ads and categorizing the ads according to their preferences. The merchants can log on to the system with an ID and a password insuring privacy of access to the ad preferences (*See* col. 5, lines 5-62). McCollom, *et al.* does not teach or suggest each of the plurality of ads or display messages having a selection probability for being displayed as recited in the subject claims. For example, in the present invention as claimed, each cluster will associate a probability to respective ads or messages within the cluster. The ads within a cluster are assigned this probability as the probability of being displayed to the user. Therefore, based on, for example, the current user and/or type of the web page, the ads or messages within a cluster will have an assigned probability of being displayed (*See* p. 12, lines 8-21). As such, the fact that the McCollom, *et al.*

09/450,262

MS137797.1

system utilizes statistical data is not sufficient to suggest a selection probability that relates to a cluster of ads. It appears the Examiner is impermissibly employing 20/20 hindsight with applicants' claimed invention serving as a roadmap to make up for the deficiencies of the McCollom, *et al.* system especially given there is no mention or suggestion of a selection probability as in the subject claimed invention.

In view of the above, it is submitted that the subject invention as recited in independent claims 1, 8, 11 and 18, (and claims 2-4, 6, 7, 9, 10, 12-14, 16, 17, 19 and 20 which respectfully depend there from), is neither anticipated nor made obvious by McCollom, *et al.* and withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 21-26 Under 35 U.S.C. §103(a)

Claims 21-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McCollom, *et al.* (US 6,343,274). Withdrawal of this rejection is respectfully requested for at least the following reasons. As noted above, McCollom, *et al.* does not disclose or suggest each and every element of independent claims 1, 8, 11, and 18 from which claims 21-26 depend. Accordingly, it is submitted that this rejection be withdrawn. Furthermore, the Examiner appears to be employing improper reasoning and/or hindsight when rejecting the respective dependent claims.

A. *The Examiner Has Improperly Cited Elements and References Without a Proper Showing of Evidence for Such Combination*

As noted by the court in *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988),

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). It can satisfy this burden **only** by **showing** some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

There is no teaching or suggestion in McCollom, *et al.* even remotely related to dynamically tailoring a web page and/or automatically changing a web page as recited in claims 21-26. The Examiner has failed to provide any evidence within the reference or evidence showing that one of ordinary skill in the art would be motivated to select the combination recited in the subject claims.

09/450,262

MS137797.1

The only evidence offered appears to be a bald assertion that the one of ordinary skill would *"know that the consumer browser would be dynamically tailored or automatically changed ... the server would customize the advertisements sent to the consumer."*

The above assertion also appears to be based on improper hindsight, in which the Examiner has selected and combined individual features from prior art, not based on teachings from the references themselves, but instead based on employing the subject claims as a roadmap. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, **in the prior art**, to combine the elements." *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997) (emphasis added). In particular, there is no teaching or suggestion in *McCollom, et al.* regarding dynamic or automated actions which are initiated in accordance with information regarding a current cluster. Therefore, the purported obviousness conclusion based on *McCollom, et al.* appears to be based on improper hindsight, in which the subject application provides the missing teaching or suggestion. See, for example, *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998).

In view of the above, it is respectfully submitted that the subject invention as recited in claims 21-26 is not obvious in view of *McCollom, et al.* To the extent that the Examiner is taking Official Notice of such dynamic tailoring and automated processes recited in the respective claims, applicants' representative respectfully request a showing of evidence from the Examiner in support of such Official Notice in accordance with MPEP §2144.03. This rejection should be withdrawn.

09/450,262

MS137797.1


III. Conclusion

The present application is believed to be condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

The Examiner is invited to contact applicants' undersigned representative over the telephone to expedite favorable prosecution of the subject application.

Respectfully submitted,
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